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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,191	11/25/2003	Terry M. Olkin	60468.300204	1190

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EXAMINER

GELAGAY, SHEWAYE

ART UNIT	PAPER NUMBER
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2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/707,191

Applicant(s)

OLKIN ET AL.

Examiner

Shewaye Gelagay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/28/05, 3/31/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-27 have been examined.

Information Disclosure Statement

2. The information disclosure statement filed 3/31/06 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The copy of the "AUSTRALIAN PATENT OFFICE, Written Opinion, App. No. SG 200503239-6" has not been provided.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 5, 14, 19, 23 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 5, 14, 19, 23 and 26 recite "authentication assertion" The

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Applicant teaches the use of "authentication assertion" throughout the specification but has not explicitly disclose what exactly an "authentication assertion" is and what is included in the authentication assertion in the application as filed.

5. Claims 2-4, 6-13, 15-18, 20-22, 24-25 and 27 depend from respective independent claims 1, 5, 14, 19, 23 and 26, hence inherit the deficiencies of the independent claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andivahis et al. (hereinafter Andivahis) U.S. Patent Number 7,146,009 in view of Favazza et al. (hereinafter Favazza) U.S. Publication Number 2004/0139319.

As per claims 1, 5, 14, 19, 23 and 26:

Andivahis teaches a method for a transaction source and a transaction target to exchange a transaction that cannot be repudiated, the method comprising:

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(a) receiving a request for a transaction identifier to identify the transaction, wherein said request includes a source authentication assertion;

(col. 4, lines 22-37)

(b) verifying said source authentication assertion; (col. 4, lines 40-45)

(c) storing said transaction identifier and information from said source authentication assertion, thereby establishing information making the transaction source unable to plausibly repudiate once it encrypts and sends the transaction;

(col. 4, lines 61-col. 5, line 9)

(d) providing said transaction identifier in reply to said request so that the transaction and said transaction identifier can be sent to the transaction target;

(col. 4, lines 61-col. 5, line 9)

(e) receiving a second request for a decryption key to decrypt the transaction once it has been received by the transaction target, wherein said second request includes said transaction identifier and a target authentication assertion; (col. 6, lines 24-29)

(f) verifying said target authentication assertion; (col. 6, lines 45-49)

(g) storing information from said target authentication assertion with the transaction identifier; (col. 6, lines 50-67) and

(h) providing said decryption key in reply to said second request so that the transaction can be decrypted, thereby establishing information making the transaction target unable to plausibly repudiate being a recipient of the transaction. (col. 6, lines 50-67)

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Andivahis does not explicitly disclose receiving a first request includes an authentication assertion. Favazza in analogous art, however, discloses a first request includes an authentication assertion. (page 1, paragraphs 9 and 10) Therefore it would have been obvious to one ordinary skill in the art to modify the method disclosed by Andivahis with Favazza in order to have a system that enables sharing information in a secure environment by utilizing assertions that are embedded in transport and messaging networks. (page 1, paragraphs 6 and 7; Favazza)

As per claims 2, 6, 20 and 24:

The combination of Andivahis and Favazza teaches all the subject matter as discussed above. In addition, Andivahis further discloses a method wherein said step (d) includes also providing an encryption key to encrypt the transaction. (col. 4, lines 61-col. 5, line 9)

As per claims 3, 7, 9, 12, 21 and 25:

The combination of Andivahis and Favazza teaches all the subject matter as discussed above. In addition, Andivahis further discloses a method the method further comprising: (i) receiving an information request for source information about the transaction source, wherein said information request includes said transaction identifier; (j) retrieving at least some of said information from said source authentication assertion stored in said step (c) with said transaction identifier and determining said source information therefrom; and (k) providing said source information in reply to said information request. (col. 6, lines 57-67; col. 18, lines 25-67)

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As per claims 4, 15, 22 and 27:

The combination of Andivahis and Favazza teaches all the subject matter as discussed above. In addition, Andivahis further discloses a method comprising: (i) receiving an information request for target information, wherein said information request includes said transaction identifier and information identifying the transaction target; (j) determining if said information identifying the transaction target matches with any said information from said target authentication assertion stored with the transaction identifier stored in said step (g) and determining said target information therefrom; and (k) providing said target information in reply to said information request. (col. 18, lines 25-67)

As per claims 10 and 16:

The combination of Andivahis and Favazza teaches all the subject matter as discussed above. In addition, Andivahis further discloses a method wherein: said step (c) includes also storing a decryption key usable to decrypt the transaction; and said step (g) includes also providing said decryption key, thereby facilitating decryption of the transaction by a party making said information request even when said party is not the transaction source or a target of the transaction. (col. 4, line 46-col. 6, line 15)

As per claims 11 and 17:

The combination of Andivahis and Favazza teaches all the subject matter as discussed above. In addition, Andivahis further discloses a method wherein: said information request received in said step (e) also includes the transaction; and said step (g) includes decrypting the transaction before providing said

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source information in reply to said information request. (col. 4, line 46-col. 6, line 15)

As per claims 13 and 18:

The combination of Andivahis and Favazza teaches all the subject matter as discussed above. In addition, Favazza further discloses a method wherein said step (g) includes also providing the transaction in decrypted form in said reply to said information request, thereby facilitating a party making said information request being able to confirm the content of the transaction even when said party is not the transaction source or a target of the transaction.

(page 3, paragraphs 40-43)

As per claims 15, 17, 22 and 27:

The combination of Andivahis and Favazza teaches all the subject matter as discussed above. In addition, Andivahis further discloses a method comprising: (e) receiving an information request for target information, wherein said information request includes said transaction identifier and information identifying the transaction target; (f) retrieving at least some of said information from said target authentication assertion stored in said step (c) with said transaction identifier and determining said target information therefrom; and (g) providing said target information in reply to said information request. (col. 18, lines 25-67)

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8. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 5, 14, 19, 23 and 26 rejected under 35 U.S.C. 102(b) as being anticipated by Linehan et al. (hereinafter Linehan) US Patent Number 5,495,533.

As per claims 1, 5, 14, 19, 23 and 26:

Linehan teaches a method for a transaction source and a transaction target to exchange a transaction that cannot be repudiated, the method comprising:

(a) receiving a first request for a transaction identifier to identify the transaction, wherein said request includes a source authentication assertion; (col. 7, lines 30-38; col. 9, lines 25-41)

(b) verifying said source authentication assertion; (col. 7, lines 30-38; col. 9, lines 25-41)

(c) storing said transaction identifier and information from said source authentication assertion, thereby establishing information making the transaction source unable to plausibly repudiate once it encrypts and sends the transaction; (col. 7, lines 40-53; col. 9, lines 25-41)

(d) providing said transaction identifier in reply to said request so that the transaction and said transaction identifier can be sent to the transaction target; (col. 7, lines 54-67; col. 9, lines 25-41)

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(e) receiving a second request for a decryption key to decrypt the transaction once it has been received by the transaction target, wherein said second request includes said transaction identifier and a target authentication assertion; (col. 7, lines 54-67; col. 9, lines 42-58)

(f) verifying said target authentication assertion; (col. 6, lines 45-49; col. 9, lines 42-58)

(g) storing information from said target authentication assertion with the transaction identifier; (col. 6, lines 50-67; col. 9, lines 42-58) and

(h) providing said decryption key in reply to said second request so that the transaction can be decrypted, thereby establishing information making the transaction target unable to plausibly repudiate being a recipient of the transaction. (col. 6, lines 50-67; col. 9, lines 42-58)

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shewaye Gelagay whose telephone number is 571-272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shewaye Gel'agay


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER